

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Schwab et al

Serial No.: 09/877,628

Group No.: 2654

Filed: June 8, 2001

Examiner: Chawan

For: DATA TRANSMISSION SYSTEM WITH ENHANCEMENT DATA

APPELLANTS' APPEAL BRIEF UNDER 37 CFR §41.37

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Barry H. Schwab and John G. Posa, Applicants and Appellants.

II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 4 claims. Claim 2-4 have been canceled, and claims 5 and 6 were added by previous amendments. Claim 5 is being canceled by an after-final amendment attached hereto. Claims 1 and 6 are pending, rejected and under appeal. Claims 1 and 6 are independent claims.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

An after-final amendment is attached hereto.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of enhancing an electronic communication, comprising the steps of transmitting and receiving a message or file having a content; and storing, at the location of a recipient, enhancement information enabling the recipient of the message or file to more fully appreciate the content. (Specification, page 2, lines 1 to 5).

Independent claim 6 is directed to a method of enhancing an electronic communication, comprising the steps of transmitting and receiving a message or file having a content; and storing, at the location of a recipient, phonemes enabling the recipient to listen to the content in a synthesized voice of the sender. (Specification, page 2, lines 17-20).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,802,314 to Tullis et al. in view of U.S. Patent No. 5,111,409 to Gasper.

B. The rejection of claims 5 and 6 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,802,314 to Tullis et al. in view of U.S. Patent No. 6,035,273 to Spies.

VII. Argument**A. Claim 1**

Claim 1 stands rejected under 35 U.S.C. §103(a) over Tullis et al. in view of Gasper. Tullis resides in a method and apparatus for processing messages which may have image, audio, text and other types of information mixed in a single message, for example, a message that includes mixed voice information, image information (color or otherwise) text information and binary information. The Tullis invention also relates to a method and apparatus for creating, editing and displaying such messages in a multimedia environment, and for electronically sending and receiving such messages via different transmission devices including facsimile, voice telephone and modem. ('314 Patent, col. 1, lines 20-30).

The Examiner concedes that Tullis does not teaches storing enhancement information at the location of a recipient which enables the recipient to visualize the sender. For some reason, the Examiner cites col. 16, lines 61-65 of Tullis, which read as follows:

"If in step S1320 the send message option is not selected but in step S1322 the save message option is selected then in step S1323 CPU 40 saves the current message

in RAM 44 or other memory such as fixed disk 43, as designated by the user.”

In an attempt to fill the void in Tullis’ disclosure, the Examiner cites Gasper. According to Gasper, a general purpose computer, such as a personal computer, is programmed for sound-synchronized random access and display of synthesized actors (“synactors”) on a frame-by-frame basis. (‘409 Patent, Abstract) A synactor is defined as combination of sixteen predefined images; eight images to be synchronized with speech and eight images to provide additional animated expression. Once created, a synactor may be manipulated similarly to a file or document in any application. Once created, a synactor is controlled with scripts defined and edited by a user via the user interface. Overall, Gasper resides in a workstation directed to animation; the patent has nothing to do with communications, per se, or the storage of “enhancement information” for application to a received communication.

The Examiner’s “argument,” however, is that since Gasper teaches “storing audio information as well as video information,” it would have been obvious to combine Tullis and Gasper “because this would enable the recipient to recall at a future date the message according to user’s preference.” In support of this argument, the Examiner relies upon Figure 1 of Gasper, also shown below:

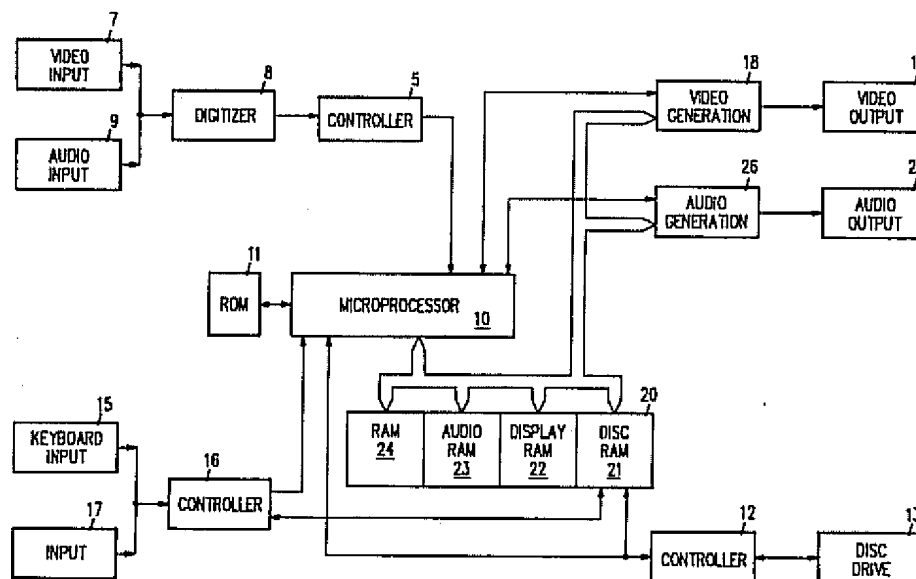


FIG. 1

Thus it appears to be the Examiner’s position that the block diagram above, in conjunction with the reproduced passage of Tullis, renders Appellants’ invention obvious. Appellants respectfully

disagree.

In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011,1017,154 USPQ 173, 177 (CCPA 1967), cert. denied, 389U.S. 1057 (1968). The Federal Circuit has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

In this case, the Examiner has presented no evidence that would have led a skilled person to combine the relevant teachings of the references to arrive at the claimed invention. The Examiner has referred to no objective teaching that would lead that individual to combine the relevant teachings of the references. The argument that the proposed combination "would enable the recipient to recall at a future date the message according to user's preference," does not solve any problem stated by Appellants or any other reference. "User's preference" is so nebulous and ill-defined that it could mean just about anything. *Prima facie* obviousness has simply not been established.

B. Claim 6

Claim 6 stands rejected under 35 U.S.C. §103(a) over Tullis et al. in view of Spies. The teachings of Tullis were discussed above with reference to claim 1. Claim 6 includes the limitation of storing, at the location of a recipient, phonemes enabling the recipient to listen to the content [of a message] in a synthesized voice of the sender. The Examiner concedes that Tullis "does not teach the method of claim 6," but argues that the Tullis/Spies combination is justified on the grounds that "this would effectively reduce the bandwidth requirements in the field video telephony applications [sic]."

Apart from the fact that this 'goal' is ill-defined and disparate from the teachings of Appellants and the prior art, Spies *does not teach the use of phonemes*. Rather, Spies resides in a speech-to-text-to-speech system to reduce audio bandwidth. When a connection is established between a calling party to a called party, the speech profile of the calling party is transmitted to and stored at the called party, and the speech profile of the called party is transmitted to and stored at the calling party. When either one of the parties speaks, that party's speech is converted into text via means for converting speech to text using that party's speech profile. The text is transmitted from the speaking party to the listening party, where it is converted back into speech by the means for converting text to speech, again using the speaking party's speech profile. Because speech typically occurs at a rate of between 4 and 5 words per second with an average of 4.2 characters per word, normal speech generates approximately 20 characters per second. Assuming the formatted text uses 8 bits to define a character such as for standard ASCII text plus hypertext characters, the system of the invention transmits speech at a data rate of 160-300 bits per second, a data rate significantly lower than known speech compression techniques. ('273 Patent, Summary of the Invention).

Thus, not only does Spies fail to disclose or suggest the use of phonemes, the "speech profiles" are used to convert speech to text and vice-versa. Since Appellant's invention would not result even if the proposed combination were legitimate, *prima facie* obviousness has not been established.

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellants seek the Board's concurrence at this time.

Respectfully submitted,

By: _____

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APPENDIX A

CLAIMS ON APPEAL

1. A method of enhancing an electronic communication, comprising the steps of:
transmitting and receiving a message or file having a content; and
storing, at the location of a recipient, enhancement information enabling the recipient to visualize
the sender.

6. A method of enhancing an electronic communication, comprising the steps of:
transmitting and receiving a message or file having a content; and
storing, at the location of a recipient, phonemes enabling the recipient to listen to the content in a
synthesized voice of the sender.

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APPENDIX B

EVIDENCE

None.

APPENDIX C

RELATED PROCEEDINGS

None.